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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1875.1410000

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/963,671

Filed

September 27, 2001

First Named Inventor

Lisa V. Denney

Art Unit

2623

Examiner

Chowdhury, Sumaiya A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 36,013

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Robert Sokohl

Typed or printed name

(202) 371-2600

Telephone number

January 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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635,609



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Denney *et al.*

Appl. No.: 09/963,671

Filed: September 27, 2001

For: **Method and System for Flexible  
Channel Association**

Confirmation No.: 8981

Art Unit: 2623

Examiner: Chowdhury, Sumaiya A.

Atty. Docket: 1875.1410000

### **Arguments to Accompany the Pre-Appeal Brief Request for Review**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

***Mail Stop: AF***

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

### ***Arguments***

Applicants' arguments in the Reply under 37. C.F.R. § 1.111 filed in response to the Office Action issued December 15, 2005, were not properly considered or responded to by the Examiner in the final Office Action issued July 26, 2006. The Examiner's response was legally and factually deficient because the Examiner failed to show where any of the cited references teach a media access controller, including: a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications

device is linked to the first communications device over a slave interface, as recited in independent claim 14.

For a rejection to be legally adequate under 35 U.S.C. § 102, every claim limitation must be taught in a single reference. *Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). The absence of any claimed element from the reference negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). For a rejection to be legally adequate under 35 U.S.C. § 103, every claim limitation must similarly be taught, or be obvious to person of ordinary skill in the art, in the combination of the references. *See Orthopedic Equipment, Inc. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983).

The Examiner rejected independent claim 14 as being unpatentable under 35 U.S.C. 103(a) over U.S. Patent Publication No. US 2002/0144284 A1 to Burroughs *et al.* ("Burroughs") in view of International Publication No. WO 01/17167 to Hebsgaard *et al.* ("Hebsgaard"). See Office Action, page 2. The Examiner relied on Burroughs and Hebsgaard to teach a media access controller, including: a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave interface, as recited in claim 14. Burroughs and Hebsgaard do not teach such a media access controller, and the

Examiner's continued rejection based on 35 U.S.C. § 103(a) is therefore legally and factually deficient.

As is known in the art, and discussed in the Related Art section of the present application, a headend device typically has a one downstream channel and multiple upstream channels. A master-slave interface between two headend devices can be used to increment the number of upstream channels. This master-slave interface, however, typically forces all upstream channels to be associated with a single downstream channel, which leaves a downstream channel unused. The claimed invention solves this and other problems by providing a system for associating a plurality of upstream channels with a plurality of downstream channels.

In the Office Action, the Examiner states that "[i]n any data-over-cable system, the cable modem must communicate some form of bandwidth request during initialization procedures, thus the CMTS must have some form of filter to receive said request." See Office Action, page 3. The Examiner goes on to allege that "Burroughs fails to teach the system communicates over a slave interface" and that Hebsgaard teaches such an interface. See Office Action, page 4. However, Burroughs and Hebsgaard, independently or in combination, do not teach or suggest a media access controller, including: a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave

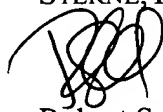
interface, as recited in claim 14. In fact, the Examiner does not even allege that such a filter as recited in claim 14 is taught or suggested in Burroughs or Hebsgaard, either independently or in combination. Rather, the Examiner contends that a headend must have some type of filter to receive bandwidth requests without reference to *any* characteristics of such a filter. Assuming, *arguendo*, that Burroughs does inherently teach a filter, there simply is no teaching or suggestion in Burroughs that the inherent filter of Burroughs has a primary filter and a secondary filter as recited in claim 14.

For at least these reasons, Burroughs and Hebsgaard, independently or in combination, do not teach or suggest the particular feature of a media access controller, including a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave interface. Because the cited references do not teach or suggest this element of claim 14, the Examiner's continued rejection of independent claim 14 over Burroughs and Hebsgaard is both legally and factually deficient.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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